

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Takashi FUJITA**

Art Unit: **2622**

Application Number: **10/577,999**

Examiner: **Timothy J. Henn**

Filed: **May 3, 2006**

Confirmation Number: **3693**

For: **SOUND-CONTROLLED ELECTRONIC APPARATUS**

Attorney Docket Number: **062489**

Customer Number: **38834**

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b)

Mail Stop: Issue Fee

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

December 30, 2010

Sir:

Applicants respectfully request reconsideration of the patent term adjustment indicated in the notice of allowance. The fee set forth in §1.18(e) is attached.

Statement of Facts

The Notice of Allowance indicates the patent term adjustment computed to date is 370 days. This computation appears to be based on 468 days of PTO delay minus 98 days of Applicant's delay, which is equal to 370 days.

Applicant does not dispute the PTO's computation of its delay of 468 days. Also, Applicant does not dispute the Patent Office's calculation of 30 days of applicant's delay due to applicant filing a Request for Continued Examination (RCE) 15 days late on August 28, 2009 when responding to the Final Office Action dated May 13, 2009 and subsequently filing another Response 15 days late on March 3, 2010 when responding to the Non-Final Office Action dated November 16, 2009.

However, it appears that the Patent Office attributes the remaining 68 days (98 days minus 30 days) of delay to the Applicant pursuant to § 1.704(d) as applied to § 1.704(c)(8) -- because applicant filed an Information Disclosure Statement (IDS) on November 4, 2009 after the RCE that was been filed on August 28, 2009.

Applicant admits that the IDS filed on November 4, 2009 was not accompanied by a separate statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement as suggested under the rule § 1.704(d).

Notwithstanding the admission above, Applicant respectfully submits that he did not fail to engage in reasonable efforts to conclude prosecution of the application for the following reasons:

First, the IDS filed on November 4, 2009 was triggered due to an issuance of foreign Office Action on October 20, 2009 in corresponding Japanese Patent Application and could not have been filed with the previously filed RCE dated August 28, 2009.

Second, none of the references cited in the Japanese Office Action were previously cited, i.e., the two references along with a copy of Japanese Office Action submitted to the Office in the IDS on November 4, 2009 were first cited.

Third, since the above-referenced application is a 371 of PCT application that entered only in US and Japan as national phase application, the international search report and all of the documents cited in the international search report were submitted to the Office in IDS dated May 3, 2006.

Last but not least, it is important to note that the Japanese Office Action that issued on October 20, 2009 was submitted to the U.S. Patent Office on November 4, 2009 and was considered by the Examiner on November 16, 2009, all of which happened in less than 30 days of receiving by any individual designated in § 1.56(c); thus, a clear evidence of diligence by the Applicant.

In addition, Applicant respectfully points out that the MPEP is replete with the examples of Patent Office's opposition to application of *per se* rule in many areas of the patent law. For example, in the area of IDS, the rule § 1.97(f), although in the context of extensions of time and not necessarily on point to the issue at hand, clearly states that "[i]f a bona fide attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance." Therefore, in view of the above, it is respectfully submitted that a bona fide attempt to comply with the requirements of Patent Office was clearly made by the Applicant even though Applicant inadvertently omitted to included the separate statement in the IDS pursuant to § 1.704(d).

To remedy this deficit, Applicant unequivocally state on the record that each item of information contained in the information disclosure statement dated November 4, 2009 was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

In view of the foregoing, Applicant respectfully request for reinstatement of the remaining 68 days (98 days minus 30 days) of patent term reduction so that the Applicant receives a total patent term adjustment of 438 days (370 days plus 68 days).

It is noted that the patent is not subject to a terminal disclaimer.

Further, it is noted that this paper is not a Rule 1.312 Amendment, but rather is an “other paper” *required* by the USPTO and should therefore be recognized as a paper that should be included in the USPTO “Examples of Papers that are *not* considered to be failures to reasonably conclude prosecution even when filed after a Notice of Allowance” as listed in 1247 O.G. 111-12 (June 26, 2001) – Clarification of 37 C.F.R. §1.704(C)(10). Therefore, filing of this paper does not negatively affect the patent term adjustment.

If any additional fees are due in connection with this paper, please charge Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

/Robert Y Raheja/

Robert Y. Raheja
Attorney for Applicants
Registration No. 59,274
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

RYR/bam